REMARKS

I.   General

Claims 1, 4-16, 19-25 and 27-36 are pending in the present application. Claims 1-15 and 25 stand objected to because of informalities. Claims 1, 4-16, 19-25 and 27-36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sansone et al. United States Patent Number 4,831,555 (hereinafter *Sansone*) in view of Schuessler United States Patent Number 2,964,232 (hereinafter *Schuessler*). In the present application, claims 1, 4-15 and 25 have been amended. Applicant respectfully traverses the rejections of record.

II.   Objections to Claims 1-15

The Office Action objects to claims 1-15 for informalities. Office Action page 2. The preamble of claim 1 states "A system comprising," yet claims 2-15 recite "The envelope . . . ." To cure the informalities, Applicant amended claims 4-15 to recite "The system . . . ." Applicant respectfully points out that the Office Action objects to claims 2 and 3 which were previously canceled. Accordingly, previously canceled claims 2 and 3 have not been amended. Therefore, it is respectfully asserted that the objections with respect to claims 1-15 should be withdrawn.

III.   Objection to Claims 25

The Office Action objects to claim 25 questioning how it is possible for a mail item to comprise a computer system. Office Action page 2. To cure the informality, Applicant has amended claim 25 to clarify "said piece of correspondence and the postage indicia thereon are printed by a computer system . . . ." Accordingly, Applicant respectfully requests the objection with respect to claim 25 be withdrawn.

IV.   35 U.S.C. § 103(a) Rejections

Claims 1, 4-16, 19-25 and 27-36 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Sansone* in view of *Schuessler*. Applicant respectfully traverses the rejections of record.

To establish a *prima facie* case of obviousness, three basic criteria must be met, see M.P.E.P. § 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of the ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Without conceding the first or second criteria, Applicant respectfully asserts that the references lack all the claim limitations.

A.   Independent Claims 1, 16, 25 and 36

Claim 1 recites "software for generating said postal item and said postage indicia and for printing said postage indicia on said postal item." The Office Action cites *Sansone* column 2, lines 1-23, column 3, lines 1-12, column 4, lines 10-15 and column 4, lines 30-55 as teaching this limitation. Office Action page 3. The cited lines discuss attaching postage to a postal item, however *Sansone* does not teach or suggest that software generates the postal item. Accordingly, *Sansone* does not teach software which generates the postage indicia and the postal item. Moreover, *Sansone* does not teach software which prints postage indicia and generates the postal item. As a result, *Sansone* does not disclose "software for generating said postal item and said postage indicia and for printing said postage indicia on said postal item."

Accordingly, Applicant has shown *Sansone* fails to teach each and every element of claim 1. Furthermore, the Office Actions does not rely on *Schuessler* to cure the above identified deficiencies. Therefore, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejection of claim 1.

Claim 16 recites "generating a piece of correspondence using a computer system [and] printing...said piece of correspondence using said computer system . . . ." The Office Action cites *Sansone* column 2, lines 1-23, column 3, lines 1-12, column 4, lines 10-15 and column 4, lines 30-55 as teaching this limitation. Office Action page 3. However, *Sansone* fails to teach or suggest that the computer system generates the piece of correspondence. Moreover, the cited lines fail to teach *Sansone*'s computer system printing a piece of correspondence, or that the correspondence is printed at all. Accordingly, *Sansone* does not

teach "generating a piece of correspondence using a computer system [and] printing...said piece of correspondence using said computer system . . . ."

Furthermore, claim 16 recites "printing said postage indicia and said piece of correspondence using said computer system, wherein said postage indicia is printed simultaneously with printing said piece of correspondence . . . ." The Office Action cites *Sansone* column 2, lines 1-23, column 3, lines 1-12, column 4, lines 10-15 and column 4, lines 30-55 as teaching this limitation. Office Action page 3. However, *Sansone* fails to teach a computer system *simultaneously* printing a piece of correspondence and postage indicia. The cited lines disclose printing postage indicia on a mail piece. Col. 4, lines 10-15. However, *Sansone* fails to disclose that the mail piece was printed, what computer system printed the mail piece, or if the mail piece was printed at all. As a result, *Sansone* fails to disclose "printing said postage indicia and said piece of correspondence using said computer system, wherein said postage indicia is printed *simultaneously* with printing said piece of correspondence . . . ."

Accordingly, Applicant has shown *Sansone* fails to teach each and every element of claim 16. Furthermore, the Office Actions does not rely on *Schuessler* to cure the above identified deficiencies. Therefore, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejection of claim 16.

Claim 25 recites "[a] piece of correspondence and the postage indicia thereon are printed by a computer system operable under control of software for generating documents and postage indicia . . . ." The Office Action cites *Sansone* column 4, lines 10-15 as teaching this limitation. Office Action page 3. However, *Sansone* fails to teach a computer system printing a piece of correspondence *and* the postage indicia thereon. *Sansone* discusses printing postage directly upon a mail piece. Col. 4, lines 10-15. However, as explained with regards to claim 16, the cited lines fail to disclose *Sansone*'s computer system printing the mail piece. Accordingly, *Sansone* does not teach "[a] piece of correspondence and the postage indicia thereon are printed by a computer system operable under control of software for generating documents and postage indicia . . . ."

Accordingly, Applicant has shown *Sansone* fails to teach each and every element of claim 25. Furthermore, the Office Actions does not rely on *Schuessler* to cure the above

identified deficiencies. Therefore, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejection of claim 25.

Claim 36 recites "printing a piece of correspondence using a computer system . . . ." The Office Action cites *Sansone* column 2, lines 1-23, column 3, lines 1-12, column 4, lines 10-15 and column 4, lines 30-55 as teaching this limitation. Office Action page 3. However, as explained with regards to claim 16, *Sansone* fails to disclose printing a piece of correspondence whatsoever, much less a computer system printing the piece of correspondence. Accordingly, *Sansone* does not teach this limitation of claim 36.

Moreover, claim 36 recites "said piece of correspondence comprising a document generated by said computer system and a postage indicia generated by said computer system . . . ." The Office Action cites *Sansone* column 2, lines 1-23, column 3, lines 1-12, column 4, lines 10-15 and column 4, lines 30-55 as teaching this limitation. Office Action page 3. However, *Sansone* fails to disclose a computer system generating a piece of correspondence *and* a postage indicia. While, *Sansone* teaches a computer system generating a postage indicia, *Sansone* fails to teach which, if any, computer system generates the piece of correspondence. Accordingly, Applicant respectfully asserts *Sansone* fails to teach "said piece of correspondence comprising a document generated by said computer system and a postage indicia generated by said computer system . . . ."

Accordingly, Applicant has shown *Sansone* fails to teach each and every element of claim 36. Furthermore, the Office Actions does not rely on *Schuessler* to cure the above identified deficiencies. Therefore, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejection of claim 36.

B.   Dependent Claims 4-15, 19-26 and 27-35

Claims 4-15, 19-26 and 27-35 depend from claims 1, 16 and 25 respectfully and inherit the limitations therein. Therefore, at least for the reasons set forth above, claims 4-15, 19-26 and 27-35 are not taught by *Sansone* in view of *Schuessler*. Furthermore, dependent claims 4-15, 19-26 and 27-35 contain further limitation not taught by the suggested combination.

For example, claims 4 and 19 recite "wherein said postage includes a machine readable portion." The Office Action cites column 4, lines 30-55 of *Sansone* as teaching this limitation. Office Action page 3. However, the cited lines disclose a Postal Service representative reading and inputting a number. Col. 4, lines 41-42. A system or method involving a person reading a number off a postage indicia fails to disclose a postage indicia having a *machine readable* a portion. Accordingly, because *Sansone* fails to disclose "wherein said postage includes a machine readable portion," Applicant respectfully requests withdrawal of the rejections of record.

In another example, claims 5 and 20 read "wherein said machine readable portion comprises a two dimensional bar code." The Office Action fails to point to anything in the suggested combination as teaching this claim. Furthermore, Applicant's review of the disclosure of *Sansone* in view of *Schuessler* does not reveal a postmark with a two dimensional bar code. Therefore, Applicant respectfully request withdrawal of the 35 U.S.C. §103(a) rejections of record.
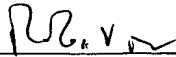
V.   Conclusion

In view of the above, applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 61135/P004CP1CP1C2/10107404 from which the undersigned is authorized to draw.

Dated: April 27, 2006   Respectfully submitted,

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